

REMARKS

NEWLY ADDED CLAIMS 21 - 23

Newly added claim 21 is claim 2, as originally submitted, rewritten in independent form and includes all of the limitations of original claim 2 and its base claim, claim 1.

Newly added claim 22 is claim 5, as originally submitted, rewritten in independent form and includes all of the limitations of original claim 5 and its base claim, claim 1.

Newly added claim 23 is claim 9, as originally submitted, rewritten in independent form and includes all of the limitations of original claim 9 and its base claim, claim 1.

Therefore, it is respectfully submitted that newly added claims 21, 22 and 23 do not constitute new matter, and that such claims should be entered. Such is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. §101

In the Office Action dated September 22, 2004, the Examiner rejected claims 1 and 17-20 under 35 U.S.C. §101 as claiming the same invention as that of claims 1-24 of prior U.S. Patent No. 6,638,584. The Examiner stated:

"Claims 1 and 17-20 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-24 of prior U.S. Patent No. 6,638,584. This is a double patenting rejection.

There is no patentable difference between the corrugated decorative grass of the patent and that of the instant claims, the method steps notwithstanding."

The above stated rejection of the Examiner has been obviated by the present Amendment in that claims 1 and 17-20 have been cancelled. Thus, no further comments concerning the Examiner's rejection of claims 1 and 17-20, or his rationale in support of such rejection, is believed necessary in order to be fully responsive to the Office Action.

In the Office Action, the Examiner also rejected Applicant's claim 17-20 under 35 U.S.C. §101, stating that such claims claim the same invention as that of claims 1-6 of prior U.S. Patent No. 6,277,472. In support of the double patenting rejection, the Examiner stated,

"Claims 17-20 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6 of prior U.S. Patent No. 6,277,472. This is a double patenting rejection.

There is no patentable difference between the corrugated decorative grass of the patent and that of the instant claims, the method steps notwithstanding."

The above stated rejection of the Examiner of claims 17-20 under 35 U.S.C. §101 has been obviated by the present Amendment in that claims 17-20 have been cancelled. Thus, no further comments concerning the Examiner's rejection of claims 17-20, or his rationale in support of such rejection, is believed necessary in order to be fully responsive to the Office Action.

CLAIM REJECTIONS UNDER OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

In the Office Action dated September 22, 2004, the Examiner rejected claims 1-20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,638,584. In support of the rejection, the Examiner stated,

"Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations recited in the subject application are encompassed in the claims of the patent. The claims of the patent recite a corrugated decorative grass comprising a plurality of segments having at least one surface thereof modified to provide the segments with a cloth appearance and a plurality of folds comprising a first leg, a second leg and a fold crease from which the first and second leg extend wherein the segments are formed from a sheet or web of material

selected from the group consisting of paper, foil, polymeric film and combinations thereof. The claims further recite a three dimensional corrugated decorative grass comprising a plurality of segments produced by cutting a sheet of folded material having a plurality of folds wherein each fold is provided with a fold line and wherein the cutting of the sheet of folded material is in an angular direction (oblique and/or 45 degree) relative to the fold lines of the folds.

The only difference is that the claims of the subject application recite the sheet of material is provided with a printed design and an embossed design. It would have been as (sic) obvious design choice to the skilled artisan to provide any design to the sheet of material recited in the claims of the patent in order to impart the desired texture or look to the sheet of material."

The before stated rejection by the Examiner of claims 1-20, as applicable to newly added claims 21, 22, 23 and dependent claims 3, 4, 6, 7 and 10-16, under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,638,584 has been obviated by the filing herewith a Terminal Disclaimer wherein the term of any patent granted on the subject matter of the claims now pending in the application will not extend beyond the term of U.S. Patent No. 6,638,584. As the rejection applies to claim 1, 5, 8, 9 and 17-20, such claims have been cancelled by the present Amendment. Therefore, it is Applicant's belief that no further comments concerning the before stated rejection is necessary in order to be fully responsive to such rejection.

In the Office Action dated September 22, 2004, the Examiner rejected claims 1-16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-6 of U.S. Patent No. 6,277,472. In support of the rejection, the Examiner stated,

“Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations recited in the subject application are encompassed in the claims of the patent. The claims of the patent recite a corrugated decorative grass comprising a plurality of segments having at least one surface thereof modified to provide the segments with a cloth appearance and a plurality of folds comprising a first leg, a second leg and a fold crease from which the first and second legs extend wherein the segments are formed from a sheet or web of material selected from the group consisting of paper, foil, polymeric film and combinations thereof. The claims further recite a three dimensional corrugated decorative grass comprising a plurality of segments produced by cutting a sheet of folded material having a plurality of folds wherein each fold is provided with a fold line and wherein the cutting of the sheet of folded material is in an angular direction (oblique and/or 45 degree) relative to the fold lines of the folds.”

The before stated rejection of the Examiner of claims 1-16, as applicable to newly added claims 21-23 and the dependent claims remaining in the application, under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,277,472 has been obviated by the cancellation of claims 1, 2, 5, 8 and 9 and the filing herewith of a Terminal Disclaimer wherein the term of any patent granted on the subject matter of the claims now pending in the application will not extend beyond the term of U.S. Patent No. 6,277,472.

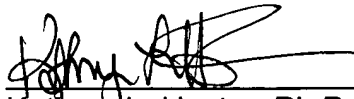
Therefore, it is respectfully requested that the Examiner withdraw his rejection and pass such claims to issue.

Conclusion

It is respectfully submitted that the claims are now in condition for allowance and it is requested that the Examiner withdraw the rejection of the claims now pending in the application (as amended) and pass such claims to issue.

The foregoing is intended to be a complete response to the Office Action dated September 22, 2004. Should the Examiner have any questions regarding the contents of this response, or any other matter, the undersigned would welcome a telephonic interview with the Examiner to discuss such matters.

Respectfully submitted,



Kathryn L. Hester, Ph.D., Reg No. 46,768
DUNLAP, CODDING & ROGERS, P.C.
Customer No. 30589
P.O. Box 16370
Oklahoma City, Oklahoma 73113
Telephone No. (405) 607-8600
Fax No. (405) 607-8686

Agent for Applicant